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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,810	05/10/2001	Brian R. Gareau	00-762	5489
719	7590	04/05/2006	EXAMINER	
CATERPILLAR INC. 100 N.E. ADAMS STREET PATENT DEPT. PEORIA, IL 616296490			MEINECKE DIAZ, SUSANNA M	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/852,810	<b>Applicant(s)</b> GAREAU ET AL.	
	<b>Examiner</b> Susanna M. Diaz	<b>Art Unit</b> 3623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 23 January 2006.

2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-29 and 34-42 is/are pending in the application.

4a) Of the above claim(s) 13-15, 20-22, 27-29, 34-36, 38 and 40 is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-12, 16-19, 23-26, 37, 39, 41 and 42 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All    b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____
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### **DETAILED ACTION**

1. This final Office action is responsive to Applicant's amendment filed January 23, 2006.

Claims 1-12, 16-19, 23-26, 37, and 39 have been amended.

Claims 30-33 have been cancelled.

Claims 41 and 42 have been added.

Claims 13-15, 20-22, 27-29, 34-36, 38, and 40 stand as non-elected claims.

Claims 1-12, 16-19, 23-26, 37, 39, 41, and 42 are presented for examination.

### ***Response to Arguments***

2. Applicant's arguments filed January 23, 2006 have been fully considered but they are not persuasive.

Applicant broadly asserts that the claim amendments overcome the previously pending rejections; however, these rejections have been modified to address the recently amended claim language.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-12, 16-19, 23-26, 37, 39, 41, and 42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Under the statutory requirement of 35 U.S.C. § 101, a claimed invention must produce a useful, concrete, and tangible result. For a claim to be useful, it must yield a result that is specific, substantial, and credible (MPEP § 2107). A concrete result is one that is substantially repeatable, i.e., it produces substantially the same result over and over again (*In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000)). In order to be tangible, a claimed invention must set forth a practical application that generates a real-world result, i.e., the claim must be more than a mere abstraction (*Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77). (Please refer to the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" for further explanation of the statutory requirement of 35 U.S.C. § 101.)

Claim 1 generates a result of "determining a first action assessment data reflecting an effect of the implemented first action on the organization based on the collected data." As best understood by the examiner, while a computer may be used to consolidate data for analysis, the actual analysis is performed by a human. Consequently, the result yielded by claim 1 (e.g., assessment data) is subjective in nature and depends entirely on the person carrying out the invention. Such a result would not necessarily be specific, substantial, or credible because of the inconsistency of the result when repeating the recited method; therefore, claim 1 fails to produce a useful result. For similar reasons, the result of claim 1 is not substantially repeatable. The result may vary widely depending on who is practicing the recited method, his/her mood, etc. Additionally, this same assessment result is not manifested as a real-world one, thereby rendering it intangible or abstract. For example, the result may be nothing

more than a decision made in the mind of a user without yielding any physical effect in the real world.

Similarly, any potentially significant analysis or data input is gleaned directly from human users, thereby rendering such analysis and data purely subjective. There is no manipulation of this analysis and data in a manner that yields consistent or meaningfully quantifiable results. While claims 6 and 7 recite that average data values for various sets of quantitative questions are determined and compared to further infer a theme, it is not clear that the averages of the data values for the question sets represent useful, concrete, and tangible quantitative values. Even if the average data values are quantitative in nature, it is not clear that an assessment of these average data values translates into results that are useful, concrete, and tangible. For example, the claimed invention is directed toward determining themes, but the specification implies that such a determination is made by a human. The average data values are not used in a repeatable methodology that provides consistent results when evaluating themes. Instead, a human would use subjectivity when gleaning information from the average data values. Additionally, looking at claim 4, it is still unclear who or what establishes the standards to determine whether or not communication between employees and managers are ineffectual. Without the specifics of the measures imparted by quantitative feedback and their limit to meaningful and useful values and corresponding analyses, related analyses are not useful, concrete, or tangible since the corresponding results are completely at the mercy of the subjectivity of a human user, which is not

substantially repeatable. Therefore, claims 1-8, 41, and 42 are deemed to be non-statutory for failure to produce a useful, concrete, and tangible result.

Claims 16-19 and 37 recite method claims with limitations similar to those recited in claims 1-8, 41, and 42; therefore, the same rejections apply.

Claims 9-12 and 39 recite apparatus claims with limitations similar to those recited in claims 1-8; therefore, the same rejections apply. Furthermore, claims 9-12 and 39 are written in means-plus-function format. Looking toward the specification, it is not clear whether or not Applicant intended each means to correspond to a computer or human. Means-plus-function language requires corresponding structural limitations in the specification; however, the specification discloses that a human user performs much of the recited functionality. For example, does the computer actually determine a theme, an action corresponding to the determined theme, and an action assessment data reflecting an effect of the implemented action on the organization based on collected data or does the computer merely sort and present the data to then allow a human user to perform the recited analysis (claim 9)? Looking toward the specification, it appears that the human user is actively performing the recited analysis while a computer merely assists in organizing the data needed to make related decisions. Consequently (and as discussed above), the subjective nature of the analysis renders any claimed results non-statutory for failure to be useful, concrete, and tangible.

Claims 23-26 recite a system comprising a computer program product with limitations similar to those recited in claims 1-12, 39, 41, and 42; therefore, the same rejections apply. Please note that the issues of which steps are actually meant to be

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performed by a computer versus a human (raised more explicitly in claims 9-12 and 39) are especially pertinent to the discussion of claims 23-26. Consequently (and as discussed above), the subjective nature of the analysis renders any claimed results non-statutory for failure to be useful, concrete, and tangible.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-12, 16-19, 23-26, 37, 39, 41, and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As discussed in the rejection under 35 U.S.C. § 101, claims 1-12, 16-19, 23-26, 37, 39, 41, and 42 do not produce a useful, concrete, and tangible result. Since the claimed results are purely dependent on human subjectivity, the results of the claimed invention cannot be substantially repeated. Consequently, the Examiner submits that one of ordinary skill in the art would not be enabled to consistently make and/or use the claimed invention as intended by Applicant without undue experimentation.

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7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-12, 16-19, 23-26, 37, 39, 41, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 generates a result of "determining a first action assessment data reflecting an effect of the implemented first action on the organization based on the collected data." As best understood by the examiner, while a computer may be used to consolidate data for analysis, the actual analysis is performed by a human. Consequently, the result yielded by claim 1 (e.g., assessment data) is subjective in nature and depends entirely on the person carrying out the invention, thereby rendering the scope of the recited determining and analysis steps unclear. To what extent is a computer involved, if at all? Does a human merely make an arbitrary and subjective decision in his/her own mind?

Similarly, any potentially significant analysis or data input is gleaned directly from human users, thereby rendering such analysis and data purely subjective. There is no manipulation of this analysis and data in a manner that yields consistent or meaningfully quantifiable results. While claims 6 and 7 recite that average data values for various sets of quantitative questions are determined and compared to further infer a theme, it is not clear that the averages of the data values for the question sets represent useful, concrete, and tangible quantitative values, thereby rendering these claims vague and indefinite. Even if the average data values are quantitative in nature, it is not clear that



an assessment of these average data values translates into results that are useful, concrete, and tangible. For example, the claimed invention is directed toward determining themes, but the specification implies that such a determination is made by a human. The average data values are not used in a repeatable methodology that provides consistent results when evaluating themes. Instead, a human would use subjectivity when gleaning information from the average data values. Additionally, looking at claim 4, it is still unclear who or what establishes the standards to determine whether or not communication between employees and managers are ineffectual.

Claims 16-19 and 37 recite method claims with limitations similar to those recited in claims 1-8, 41, and 42; therefore, the same rejections apply.

Claims 9-12 and 39 recite apparatus claims with limitations similar to those recited in claims 1-8, 41, and 42; therefore, the same rejections apply. Furthermore, claims 9-12 and 39 are written in means-plus-function format. Looking toward the specification, it is not clear whether or not Applicant intended each means to correspond to a computer or human. Means-plus-function language requires corresponding structural limitations in the specification; however, the specification discloses that a human user performs much of the recited functionality. For example, does the computer actually determine a theme, an action corresponding to the determined theme, and an action assessment data reflecting an effect of the implemented action on the organization based on collected data or does the computer merely sort and present the data to then allow a human user to perform the recited analysis (claim 9)? Looking toward the specification, it appears that the human user is actively performing the

recited analysis while a computer merely assists in organizing the data needed to make related decisions; however, a human cannot qualify as a “means” since there is no structure attributable to a human in conformance with 35 U.S.C. § 112, 6<sup>th</sup> paragraph.

Claims 23-26 recite a system comprising a computer program product with limitations similar to those recited in claims 1-12, 39, 41, and 42; therefore, the same rejections apply. Please note that the issues of which steps are actually meant to be performed by a computer versus a human (raised more explicitly in claims 9-12 and 39) are especially pertinent to the discussion of claims 23-26.

Appropriate correction and/or clarification is required.

*Because claims 1-12, 16-19, 23-26, 37, 39, 41, and 42 are so indefinite, no art rejection is warranted as substantial guesswork would be involved in determining the scope and content of these claims. See In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962); Ex parte Brummer, 12 USPQ 2d, 1653, 1655 (BdPatApp&Int 1989); and also In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Prior art pertinent to the disclosed invention is nevertheless cited and applicants are reminded they must consider all cited art under Rule 111(c) when amending the claims to conform with 35 U.S.C. 112 and 101.*

### **Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

MacKenzie (US 2002/0065709) -- Discloses a system for analyzing results of an employee survey to determine effective areas of organizational improvement.

Guinta et al. (U.S. Patent No. 6,161,101) -- Discloses computer-aided methods and apparatus for assessing an organization process or system.

D'Alessandro (U.S. Patent No. 6,556,974) -- Discloses a method for evaluating current business performance.

Brown et al. ("Utilizing Organizational Culture Gap Analysis to Determine Human Resource Development Needs") -- Assesses cultural gap analysis within an organization using the Competing Values Framework (CVF).

Andrews ("A Model for Cultural Change") -- Discusses a cultural assessment process within an organization.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

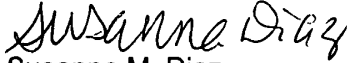
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

March 31, 2006